

Applicants traverse the rejection of Claims 22-23. In particular, Applicants submit that Dunn et al is not prior art against the instant application, since the present application and U.S. 5,955,611 are commonly owned by Pfizer Inc.

Pursuant to 35 U.S.C. § 103(c),

Subject matter developed by another person, which qualifies as prior art under one or more subsections (e), (f), and (g) of section 102 of this title, *shall not preclude patentability* under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Presumably, the Examiner has identified the Dunn et al. reference as prior art under 35 U.S.C. § 102(e). The instant application claims priority back to UK 9715380.3 (filed July 22, 1997), and is assigned to Pfizer Inc. Dunn et al, U.S. 5,955,611 – also assigned to Pfizer Inc. – was filed on June 6, 1997 and did not publish until a patent issued on September 21, 1999. Given that Dunn et al and the instant application were, at the time the invention was made, owned by Pfizer Inc., and/or the applicants were under an obligation to assign to Pfizer Inc., Dunn et al does not render Applicants' invention obvious.

Applicants, therefore, respectfully request that the Examiner withdraw the rejection of Claims 22 –23.

Rejection of Claims 22-23 under 35 U.S.C. § 103(a) – Bell et al.

The Examiner rejected Claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Bell et al (U.S. 5,272,147). In particular, the Examiner states that Bell et al discloses the instant intermediate compound of Claim 22 and the process thereof, noting that R³ and R⁴ groups of Bell et al. overlap with the corresponding R³ and R⁴ groups of the instant application. The Examiner contends that Bell differs from the instant claims in not showing specific examples of making a compound wherein R⁴ is sulfonylamide bearing a heterocyclic group. The Examiner concludes that one of ordinary skill in the art would be motivated to make compounds variously substituted in phenyl ring and the intermediates using the process taught by Bell et al. and expect that the resulting compounds would have the uses taught by the art.

Applicants traverse the rejection of Claims 22 and 23 and request that the Examiner reconsider the rejection thereof. In particular, the R⁴ groups of Bell et al. and the instant application do not overlap. In the present application, R⁴ is limited to

-SO₂NR⁷R⁸. In contrast, there is no provision for this substituent in Bell et al. The closest R⁴ group in Bell et al. is -NHSO₂NR⁵R⁶. These substituents differ, however, because of the intervening nitrogen to which the sulfonamide group is attached in Bell et al.

Accordingly, Bell et al. does not disclose the intermediate compound described in the Claim 22. Furthermore, Bell et al. does not provide any disclosure from which one of ordinary skill in the art would be motivated to arrive at the intermediate compound of Claim 22. Likewise, one of ordinary skill in the art would not be motivated by the disclosure of Bell et al to arrive at Applicants' invention of Claim 23, wherein a process is claimed utilizing the intermediate compound of Claim 22.

Consequently, Bell et al. does not render Applicants' invention obvious. Applicants respectfully request that the Examiner reconsider the rejection of Claims 22 and 23.

CONCLUSION

Having addressed all points and concerns raised by the Examiner, Applicants submit that the application is in a condition for allowance. Applicants respectfully request an early and favorable action in this application.

Respectfully submitted,

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